

REMARKS

Claims 1 to 17 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants respectfully request that the Examiner acknowledge in the next Office communication whether the Drawings are accepted.

With respect to paragraph three (3) of the Office Action, claim 17 was rejected as non-statutory under Section 101.

Applicants do not understand why the Examiner is raising this issue in view of the recent Precedential Opinion of the Board of Patent Appeals and Interferences, Ex parte Carl A. Lundgren (paper no. 78), Appeal No. 2003-2088 (U.S. Patent Application Serial No. 08/093,516) (case Heard April 20, 2004). In this Precedential opinion, the Board addressed the precise question raised by the Examiner as to a “technological arts” test and rejected it as being inconsistent with both federal Circuit and Supreme Court law.

Under Lundgren, the Examiner has no basis whatsoever for asserting that claim 17 somehow does not meet the “technological arts” test -- since the Board made clear that there isn’t one.

To the extent that the Examiner maintains this rejection in view of Lundgren, it is respectfully requested that the Examiner explain exactly how its rejection is supported in view of the Board’s precedential Lundgren opinion.

Still further, it is respectfully submitted that claim 1 does satisfy Section 101 since it is directed to a process which is patentable and since it has utility. It is suggested that the Examiner read the Lundgren opinion, as well as MPEP at 2106 and 2107 regarding the Examination Guidelines for the utility requirement. It is also respectfully submitted that the reasons advanced in support of the rejection are simply not supported by either the Examination Guidelines or more importantly the case law, and that a *prima facie* case has not been presented as required by Sections 2106 and 2107 of the MPEP.

In this regard, the Board of Patent Appeals — in reversing another Examiner for ignoring the law of State Street — has stated that claimed subject matter having a “practical application” is § 101 statutory subject matter if it represents a “useful, concrete and tangible result” under State Street, and has further stated that the Federal Circuit’s reasoning in State

Street is “intended to be broadly construed”. See Ex parte Donner, 53 U.S.P.Q.2d 1699, 1702 (Bd. Pat. App. & Int. 1999).

Still further, the Federal Circuit -- as well as the Patent Office — has not required that *method claims* recite how the method steps are to be performed. In AT&T Corp. v. Excel Communications Inc., 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999), the Federal Circuit stated that the claims of U.S. Patent No. 5,333,184 (“the ‘184 patent”) were plainly directed to § 101 statutory subject matter. See id. at 1452. (“Excel also contends that because the process claims at issue lack physical limitations set forth in the patent, the claims are not patentable subject matter. This argument reflects a misunderstanding of our case law. . . . Since the claims at issue in this case are directed to a process in the first instance, a structural inquiry is unnecessary”).

It is therefore respectfully requested that the Section 101 rejection of claim 17 be withdrawn in view of the Lundgren precedential opinion of the Board of Patent Appeals and Interferences (in its *per curiam* opinion)

With respect to paragraph five (5), claims 1, 2, 7, 9, 10, 15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,207,580 (“Strecher”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Office Action admits that the reference does not disclose the use of scenarios. In particular claim 1 requires the storing of scenarios which includes health promotion information and health promotion timing for each of levels of readiness of change., and a the preparing of a health promotion schedule of the client from the scenario and the data. A review of the column 4 text cited in the Office Action provides no support whatsoever for the

assertions of the Office Action . In short, the Office has provided no evidence to support the assertion that the use of scenarios as provided for in the context of claim 1, as explained above, other than to rely on the teachings of the present application, and by essentially asserting its obviousness without any support for the motivation to combine a "Scenario" feature for which there is no suggestion whatsoever in the "Strecher" reference.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference does not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify the reference to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claim 1 is allowable for these reasons.

Claims 9 and 17 include features like those of claim 1 and are therefore allowable for essentially the same reasons as claim 1.

Claims 2 to 8 depend from claim 1, and are therefore allowable at least for the same reasons as claim 1. Claims 10 to 16 depend from claim 9, and are therefore allowable at least for the same reasons as claim 9.

It is therefore respectfully submitted that claims 1 to 17 are allowable, and that the obviousness rejections of the claims should be withdrawn.

With respect to paragraph six (6), claims 3, 4, 11, and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over the "Strecher" reference in view of the "Rieger" reference.

Claims 3 and 4 depend from allowable claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 3 and 4 are allowable for essentially the same reasons as claim 1, and since the "Rieger" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Rieger" reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above. Accordingly, claims 3 and 4 are allowable.

Claims 11 and 12 depend from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 11 and 12 are allowable for essentially the same reasons as claim 9, and since the "Rieger" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Rieger" reference makes clear that it simply does not in any way disclose or suggest the claim 9 features, as explained above. Accordingly, claims 11 and 12 are allowable.

With respect to paragraph seven (7), claims 5, 6, 8, 13, 14 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the "Strecher" reference in view of U.S. Patent No. 6,039,688 ("Douglass").

Claims 5, 6 and 8 depend from allowable claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 5, 6 and 8 are allowable for essentially the same reasons as claim 1, and since the "Douglass" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Douglass" reference makes clear that it simply does

not in any way disclose or suggest the claim 1 features, as explained above. Accordingly, claims 5, 6 and 8 are allowable.

Claims 13, 14 and 16 depend from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 13, 14 and 16 are allowable for essentially the same reasons as claim 9, and since the "Douglass" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Douglass" reference makes clear that it simply does not in any way disclose or suggest the claim 9 features, as explained above. Accordingly, claims 13, 14 and 16 are allowable.

It is therefore respectfully submitted that claims 1 to 17 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 1 to 17 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 11/30/05

Respectfully submitted,

By: 

Aaron C. Deditch
Reg. No. 33,865

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646